

In the subject Office Action, the Examiner withdrew claims 13 and 15-18 from further consideration as being drawn to a non-elected invention. Furthermore, the Examiner rejected claims 1-8, 12, 14, and 20-21 under 35 U.S.C. § 103(a) as being unpatentably obvious over a combination of United States Patent Nos. 5,769,830 (Parker) and 5,462,523 (Samson I). The Examiner also rejected claims 9-11 and 19 under 35 U.S.C. §103(a) as being unpatentably obvious over a combination of Parker, Samson I, and United States Patent No. 6,053,903 (Samson II).

Applicants herein provide remarks in response to the Examiner's rejections of the pending claims. Applicants do not make any amendments to the claims in response to the subject Office action.

## **REMARKS**

### **Election/Restriction Requirement and Withdrawal of Claims 13, and 15-18**

In the subject Office action, the Examiner withdrew claims 13 and 15-18 from further consideration as being drawn to a nonelected species. The Examiner stated that there is no allowable generic or linking claim.

While Applicants still believe the election and restriction requirements are improper, Applicants acknowledge the withdrawal of these claims from current consideration.

Applicants maintain the position that pending Claim 1 is generic and links all of the species as defined by the Examiner. Accordingly, Applicants respectfully request that the Examiner reconsider the Election and Restriction requirements upon allowance of Claim 1.

### **Rejection Of Claims 1-8, 12, 14, and 20-21 Under 35 U.S.C. § 103(a)**

The Examiner rejected claims 1-8, 12, 14, and 20-21 under 35 U.S.C. § 103(a) as being unpatentably obvious over a combination of Parker and Samson I. Applicants respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness in the rejection, and request withdrawal of this rejection and reconsideration of these claims.

The Examiner states that Parker fails to teach a braid extending over a coil, and that Samson I teaches a medical device with a braid extending over a coil. While Samson I does teach a device that includes a braid extending over a coil, the combination of the Parker and Samson I references is improper because the combination destroys the function of the device taught by Samson I.

A *prima facie* case of obviousness based on a combination of prior art references requires some teaching, suggestion, or motivation to combine the references. In re Rouffet, 149 F.3d 1350, 1355 (citing In re Geiger, 815 F.2d 686, 688) (Fed. Cir. 1998). The Federal Circuit has noted that this requirement serves “to prevent the use of hindsight based on the invention to defeat patentability of the invention....” *Id.* at 1357. Furthermore, the Federal Circuit has summarized the Examiner’s duty as follows: “[T]he Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *Id.*

In the subject Office action, the Examiner states that it would have been obvious to combine Parker and Samson I because “according to Samson the braid will provide extra support for the coil and allows for better maneuverability of the catheter tip.” (March 7, 2003 Office action, page 3, third full paragraph). Applicants respectfully disagree, and assert that no motivation to combine these references can be found in the art, at least because combining these references would destroy the function of the medical device taught by Samson I.

Samson I is directed to a perfusion catheter. These medical devices are used to deliver fluids to a point of treatment in a body vessel by passing the fluid through the center of the catheter and forcing the liquid out of the catheter, usually through openings in the distal tip. According to Samson I: “The perfusion tip is constructed in such a way that fluids introduced into the catheter at the proximal end perfuse out of openings in the tip.” (Samson I, c. 3, lines 61-63). Samson I describes the function of the main coil (element 118 in Figure 2) as “supporting the braid and allowing fluid within to pass to the braid and thence out into the space beyond the braid.” (Samson I, c. 4, lines 47-49).

Thus, the device taught by Samson I requires openings in the coil to allow the desired perfusion of fluids.

Parker discloses an outer layer 27 that may comprise a polymeric layer. Combining the Parker and Samson I references would destroy the function of the device taught by Samson I. Indeed, the combination of Parker with the Samson I device would render the Samson I device completely inoperable for its intended purpose. Specifically, the outer layer 27 of Parker, when applied to the Samson I device, would produce a perfusion catheter with no openings that allow fluids to escape from the catheter. The outer layer 27 would prevent such escape. As a result, one of ordinary skill in the art, with no knowledge of the invention claimed in the present application, would have had no technological motivation to combine the Parker and Samson I references.

The Federal Circuit has noted that a modification to a reference that renders the apparatus taught by the reference inoperable for its intended purpose is, in effect, a teaching away from the proposed modification. In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984). In Gordon, the Court observed that the reference would not have provided any motivation to one of ordinary skill in the art to employ a proposed modification that renders the apparatus inoperable for its intended purpose. *Id.*

Accordingly, Applicants respectfully assert that the cited art is devoid of any motivation to combine these references, and that the Examiner has not established a prima facie case of obviousness for these claims.

### **Rejection Of Claims 9-11 and 19 Under 35 U.S.C. § 103(a)**

The Examiner also rejected claims 9-11 and 19 under 35 U.S.C. §103(a) as being unpatentably obvious over a combination of Parker, Samson I, and Samson II. The Examiner relies upon the combination of Parker and Samson I as in the rejection of claims 1-8, 12, 14, and 20-21 (March 7, 2003 Office action, page 3, fifth full paragraph). As discussed above, this combination of references does not teach or suggest the claimed invention, and indeed is improper because it destroys the function of the Samson I device, rendering it inoperable for its intended purpose. Accordingly, one of ordinary skill in the art would have no motivation to combine these references. The

inclusion of Samson II in the rejection of claims 9-11 and 19 cannot cure the effect of the proposed combination of Parker and Samson I.

Accordingly, Applicants respectfully assert that the Examiner has also failed to establish a *prima facie* case of obviousness for these claims.

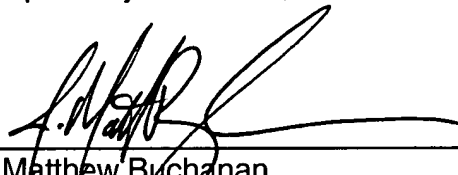
Applicants believe all pending claims define patentable subject matter, and that the Remarks made herein defeat all outstanding rejections. Applicants request that the Examiner withdrawal the rejections and issue a Notice of Allowability.

Applicants believe this reply to be fully responsive to the Office Action mailed on March 7, 2003. If the Examiner believes that personal communication would advance the prosecution of this application, Applicants respectfully request that the Examiner contact their attorney at the number listed below.

Respectfully submitted,

Dated: 9 June 2003

By:

  
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J. Matthew Buchanan  
Reg. No. 47,459  
Attorney for Applicant

BRINKS HOFER GILSON & LIONE  
Post Office Box 10395  
Chicago, Illinois 60610  
(312) 321-4281